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| 10/607,520 | 06/27/2003 | Tetsuya Sugimoto | 325772032500 | 6027 |
| 25227 7590 05/28/2008 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/607,520

Applicant(s)

SUGIMOTO, TETSUYA

Examiner

GRANT FORD

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/14/2007 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Simpson, as outlined below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2,5-10, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shikida (JP 2002-157095) in view of Simpson et al. (6,559,965), hereinafter referred to as Simpson.

The Examiner notes that all Shikida page references listed below are specifically pointing to the English translation provided by Applicants on 5/24/2007.

a. As per claim 1, Shikida discloses transmitting an address request command for requesting a network address of said printing apparatus and a network address of said client to said printing apparatus via said server (Figure 5, Pages 1-2 – see Solving Means); and

receiving the network address of said printing apparatus transmitted from said printing apparatus via said network in response to the transmission of said address request command (Pages 1-2 – see Solving Means). However, Shikida fails to explicitly disclose the use of an address request transmitted independent of a print job.

Simpson teaches transmitting an address request command independent of print data (Col 3 lines 8-13, Col 4 line 45 through Col 5 line 6, Col 6 lines 60-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of separate address request commands and print data with the prior art of Shikida. One of ordinary skill in the art would have done so for the purpose of establishing bi-directional communications between a client and a printer through the use of an address query presented to a printer which in turn responds with its address information (Abstract, Col 11 lines 7-15). The Examiner notes that while the prior art of Simpson uses the phrase "print job" to describe usage of a SOCKETPING command, the phrase "print job" is defined differently than that of the instant application. For example, in the instant application, a print job is defined as a command to print data which is received by a printer (e.g., see Para. 0056). However, the prior art of Simpson discloses that a print job need not include print data, and preferably does not include any data to be printed but rather merely includes an address request to establish a bi-directional communication path (Abstract, Col 3 lines 6-17).

b. As per claim 2, Shikida and Simpson teach the invention substantially as claimed above. However, Shikida fails to explicitly disclose transmitting a port number for specifying the control program in the transmission step.

Simpson teaches transmitting a port number for specifying the control program in the transmission step (Col 4 lines 45-67 – note print client socket). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of print client socket transmission with address requests. One of ordinary skill in the art would have done so to permit the printer to respond directly to the print client thereby establishing a direct bi-directional path between the print client and printer (Col 4 lines 45-67).

c. As per claim 5, Shikida and Simson teach the invention substantially as claimed above. Additionally, Shikida discloses wherein the network address is an IP address (Page 10 – see NIC_ADDRESS).

b. As per claim 6, Shikida discloses a printing apparatus connected to a network and provided to an environment of said network through a server, comprising:

a storage unit to store a network address allocated to said printing apparatus on said network (Pages 9-10);

an input portion to input data from said server (Pages 9-10);

a determination portion to determine whether said input data is a print job (Pages 9-10). However, Shikida fails to explicitly disclose determining that input data is not a print job.

Simpson teaches a transmission portion to transmit, when said determination portion determines that said input data is not a print job, the network address of said printing apparatus to a client specified by a network address included in said input data via said network (Col 4 lines 34-67). It would have been obvious to one

having ordinary skill in the art at the time the invention was made to incorporate the use of determining if input data is a print job with the printing system of Shikida. One of ordinary skill in the art would have done so for the purpose of determining if input data is a printer address request and if so, returning the printer address to a client for the purpose of establishing a bi-directional communication path (Abstract, Col 4 lines 34-44).

c. As per claim 7, Shikida discloses a prohibition portion to prohibit printing of said input data (Page 10).

d. As per claim 8, Shikida discloses a computer readable recording medium recording a control program executed in a client connected via a network to a server connected to a printing apparatus, said control program causing said client to execute steps of:

generating data for transmitting an address request command for requesting a network address of said printing apparatus and a network address of said client (Pages 8-9);

transmitting said address request command, said data and a print job to said printing apparatus via said server (Pages 9-10); and

receiving the network address of said printing apparatus transmitted from said printing apparatus via said network in response to the transmission of said address request command (Pages 10-11). However, Shikida fails to explicitly disclose the use of an address request transmitted independent of a print job.

Simpson teaches transmitting an address request command independent of print data (Col 3 lines 8-13, Col 4 line 45 through Col 5 line 6, Col 6 lines 60-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of separate address request commands and print data with the prior art of Shikida. One of ordinary skill in the art would have done so for the purpose of establishing bi-directional communications between a client and a printer through the use of an address query presented to a printer which in turn responds with its address information (Abstract, Col 11 lines 7-15). The Examiner notes that while the prior art of Simpson uses the phrase "print job" to describe usage of a SOCKETPING command, the phrase "print job" is defined differently than that of the instant application. For example, in the instant application, a print job is defined as a command to print data which is received by a printer (e.g., see Para. 0056). However, the prior art of Simpson discloses that a print job need not include print data, and preferably does not include any data to be printed but rather merely includes an address request to establish a bi-directional communication path (Abstract, Col 3 lines 6-17).

e. As per claim 9, Shikida discloses a step of displaying, in accordance with the reception of said network address, the received network address (Page 11).

f. As per claim 10, Shikida discloses a step of setting identification information for specifying said printing apparatus via said server, wherein said transmission step is executed in accordance with said identification information (Pages 9-10).

g. As per claim 13, Shikida discloses a computer readable recording medium recording a printer driver program executed in a computer connected to a network, said printer driver program causes said computer to execute steps of:

accepting specification of a printing apparatus administered by a server
(Pages 9-10);

transmitting an IP address of said computer to said printing apparatus
(Pages 8-10); and

receiving data transmitted from said printing apparatus and obtaining an IP address of said printing apparatus from the received data (Pages 9-11). However, Shikida fails to explicitly disclose the use of an address request transmitted independent of a print job.

Simpson teaches transmitting an IP address of said computer and an address request command for requesting a network address of said printing apparatus (Col 3 lines 8-13, Col 4 line 45 through Col 5 line 6, Col 6 lines 60-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of separate address request commands and print data with the prior art of Shikida. One of ordinary skill in the art would have done so for the purpose of establishing bi-directional communications between a client and a printer through the use of an address query presented to a printer which in turn responds with its address information (Abstract, Col 11 lines 7-15). The Examiner notes that while the prior art of Simpson uses the phrase "print job" to describe usage of a SOCKETPING command, the phrase "print job" is defined differently than that of the instant application. For

example, in the instant application, a print job is defined as a command to print data which is received by a printer (e.g., see Para. 0056). However, the prior art of Simpson discloses that a print job need not include print data, and preferably does not include any data to be printed but rather merely includes an address request to establish a bi-directional communication path (Abstract, Col 3 lines 6-17).

h. As per claim 14, Shikida and Simpson teach the invention substantially as claimed above. However, Shikida fails to explicitly disclose the use of a port number specifying a program transmitted with the IP address in the transmission step.

Simpson teaches the use of a port number specifying a program transmitted with the IP address in the transmission step (Col 4 lines 45-67 – note print client socket). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of print client socket transmission with address requests. One of ordinary skill in the art would have done so to permit the printer to respond directly to the print client thereby establishing a direct bi-directional path between the print client and printer (Col 4 lines 45-67).

i. As per claim 15, Shikida discloses a printing apparatus connected to a network and provided to an environment of said network through a server, comprising:

- a storage unit to store an address for specifying said printing apparatus on said network; a reception portion to receive data from said server (Pages 9-10);
- an obtainment portion to obtain, when a command requesting a transmission of the address of said printing apparatus is included in the received data,

an address of a transmitter of the received data included in the received data (Pages 8-11); and

a transmission portion to transmit the address of said printing apparatus stored in said storage unit to the obtained address (Pages 8-11). However, Shikida fails to explicitly disclose the use of an address request transmitted independent of a print job.

Simpson teaches the use of an address request transmitted independent of a print job (Col 3 lines 8-13, Col 4 line 45 through Col 5 line 6, Col 6 lines 60-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of separate address request commands and print data with the prior art of Shikida. One of ordinary skill in the art would have done so for the purpose of establishing bi-directional communications between a client and a printer through the use of an address query presented to a printer which in turn responds with its address information (Abstract, Col 11 lines 7-15). The Examiner notes that while the prior art of Simpson uses the phrase "print job" to describe usage of a SOCKETPING command, the phrase "print job" is defined differently than that of the instant application. For example, in the instant application, a print job is defined as a command to print data which is received by a printer (e.g., see Para. 0056). However, the prior art of Simpson discloses that a print job need not include print data, and preferably does not include any data to be printed but rather merely includes an address request to establish a bi-directional communication path (Abstract, Col 3 lines 6-17).

4. Claims 3-4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shikida and Simpson in view of Mochizuki (US 2002/0001495).

a. As per claim 3, Shikida and Simpson teach the invention substantially as claimed above. However, Shikida fails to explicitly teach a control program for outputting and instruction screen for prompting a user to input an instruction for transmitting an address request command.

Mochizuki teaches wherein said control program further causes the client to execute a step of outputting an instruction screen for prompting a user to input an instruction for transmitting said address request command, wherein said transmission step is executed on condition that said instruction for transmission is input (Para. 0051-0052). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of an input screen for prompting user input regarding instructions for transmitting an address request command with network printer systems. One of ordinary skill in the art would have been motivated to do so for the purpose of allowing a user to select localized printers from which to acquire address information (Para. 0052).

b. As per claim 4, Shikida and Simpson teach the invention substantially as claimed above. However, Shikida fails to explicitly teach the use of an instruction screen for prompting a user to input an instruction for transmitting an address request command.

Mochizuki teaches wherein an input of information for specifying said printing apparatus is accepted at said instruction screen, said information being in a format including a server name and a printing apparatus name (Para. 0051-0052). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of an input screen for prompting user input regarding instructions for transmitting an address request command with network printer systems. One of ordinary skill in the art would have been motivated to do so for the purpose of allowing a user to select localized printers from which to acquire address information (Para. 0052). The Examiner notes that in the case of an address request, the printer which returns address information in response to an address request is functioning as a server by definition.

c. As per claim 11, Shikida and Simpson teach the invention substantially as claimed above. However, Shikida fails to explicitly disclose displaying network address information of a printer on a screen for setting said identification information.

Mochizuki teaches said control program further causing said client to execute a step of displaying the network address of said printing apparatus received at said reception step on a screen for setting said identification information (Para. 0054). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of displaying returned printer information on a screen for identification information with network printing systems. One of ordinary skill in the art would have been motivated to do so for the purpose of allowing a host to determine

returned printer information's relevancy based on identification information previously entered (Para. 0054).

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shikida and Simpson in view of Ferlitsch (US 2002/0114004).

a. As per claim 12, Shikida discloses a printing apparatus connected to a network and provided to an environment of said network through a server, comprising: a storage unit to store a network address allocated to said printing apparatus on said network (Pages 9-10);

an input portion to input data from said server (Pages 9-10);

a determination portion to determine whether said input data is a print job or an address request command (Pages 9-10); and

a connection establishment portion to establish, when said determination portion determines that said input data is an address request command, a connection with a device specified by a network address included in said address request command via said network, wherein said determination portion determines based on a header of said input data (Pages 9-10). However, Shikida fails to explicitly disclose determining that input data is not a print job.

Simpson teaches a connection establishment portion to establish, when said determination portion determines that said input data is not a print job, a connection with a device specified by a network address included in said address

request command via said network (Col 4 lines 34-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of determining if input data is a print job with the printing system of Shikida. One of ordinary skill in the art would have done so for the purpose of determining if input data is a printer address request and if so, returning the printer address to a client for the purpose of establishing a bi-directional communication path (Abstract, Col 4 lines 34-44). However, while Simpson discloses the use of PJL commands and the determination of whether input data is a print job, Simpson fails to explicitly disclose wherein said determination portion determines based on a header of said input data.

Ferlitsch teaches PJL (Print Job Language) data being stored in a header (Para. 0068). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the use of header information used in determination with the printing system of Shikida-Simpson. One of ordinary skill in the art would have done so for the purpose of relaying specific requirements or requests for use with PJL (Para. 0068).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GRANT FORD whose telephone number is (571)272-8630. The examiner can normally be reached on 8-5:30 Mon-Thurs alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gmf
/Grant Ford/
Examiner, Art Unit 2141

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2142